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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,603	01/24/2002	Hideki Ito	9333/284	2928

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Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,603

Applicant(s)

ITO, HIDEKI

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/2005 has been entered.

2) The preliminary amendment filed 1/26/2005 is acknowledged. Claim 2 has been canceled.

3) Claims *1 and 3-14* are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure fails to specify that the session is formed automatically each time the writing is performed. This automatically formed of sessions as now claims in independent claims 1, 11, 13 and 14 is considered to be new matter.

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4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims 1,3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over KELLER et al (6,587,404).

KELLER et al discloses an audio device and method for managing track files as claimed in claims 1,9 and 13, comprising a display (Fig.4, display 46; Fig.7, display device 46 on front bezel 44), a read out unit for reading out track files recorded on a recordable medium (Fig.4, audio track files are read out from data storage structure 106), wherein the recordable medium contains at least one session and a session is automatically formed each time writing is performed and includes one or more track files (plurality of sessions are inherent in every recordable optical disk (CD-R, DVD-R, DVD-RW, etc.,) and a session is automatically formed each time the writing is performed (it is noted that, one session is formed at the time of writing, if the writing stop which indicated the last session is end and when the recording restart, a new session is formed,

the session includes one or more track files). The sessions are well known in optical recordable disk, which is shown in ITO et al (US 6,243,340), figure 4; ITO et al (US 6,631,107), figure 2; MURATA et al, (US 6,621,783), figure 5; MISAIZU (US 6,594,214), figure 5; HASHIMOTO (US 6,370,096), figure 4 and MURATA (US 6,363,040), figure 4. If the recordable disk is not completely record, each time recording new track files which forms a new session, this process is continued until the recordable disk is completely recorded), a controller which manages the track files recorded on the recordable medium in each session and which displays the session containing the file of an arbitrary track on the display (Fig.4, CPU 94; Fig.7, display 46 displays session 200 containing the file of an arbitrary track. See also column 15, line 1 to column 16, line 59), wherein the controller regards each session as a virtual disk, allocates a track number for each of the track files in each session and display a name of the virtual disk corresponding to the session containing the file of the arbitrary track on the display, the track number and a name of the track (Fig.7, name of virtual disk is "METALLICA", figure 8, the tracks number of the tracks are "1", "2", "3" and "4" and name of the tracks (songs) are "Fade To Black", "King Nothing", "Sad But True" and "Fuel"), *except that* recordable medium is magnetic disk (column 23, lines 18-27) rather than optical disk. Examiner take Official Notice the fact

that optical recordable disk is known in the recording art to be equivalent to magnetic disk for storing information data (both of them capable of recording and storing information data). To substitute optical recordable disk in KELLER et al for the disclosed magnetic disk would have been an obvious functional equivalent.

As to claims 3 and 4, KELLER et al shows the track files is compressed by MP-3 format (column 21, line 50 to column 22, line 7).

Claim 11 adds to claim 1 the feature of a session can be selected manually by a user by operating a next-disk key or previous-disk key of the audio device, which is shown in KELLER et al's figure 2, manually control keys 45 and 49.

Claims 5,10,12 and 14 add to claim 1 the feature of playing back the track file recorded at latest session. It would have been obvious to someone within the level of skill in the art at the time of the invention was made to play back the latest recorded track in KELLER et al's optical recording and playing device. The rationale is as follows: it has been well known and generally recognized in the art that the tracks recorded on CD or any recordable medium are capable of playing back at any directions, any sequences, randomly or selected as play-list (these features are inherent in every optical disk player, which also shows in KELLER et al's figure 2, manually control keys

43,45,47,49,50). Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to playing back the track recorded at latest session in KELLER et al's disk player as claimed.

As to claim 6, KELLER et al shows how to change the session and the tracks in the session in figures 10-12.

As to claim 7, since the audio player of KELLER et al is capable of playing back track files recorded in MP-3 format, the decoder is inherent in KELLER et al's audio player.

As to claim 8, KELLER et al shows a D/A converter in figure 4, 92.

6) Applicant's arguments filed 1/26/2005 have been fully considered but they are not persuasive.

Applicant states that each session is automatically formed each writing is performed. However, this feature is not exist in the original disclosure. Further, each time a recording is performed which creates a new session contains the track files for that recording. This feature is old and exist in most of CD-R (ITO et al (US 6,243,340), figure 4; ITO et al (US 6,631,107), figure 2; MURATA et al, (US 6,621,783), figure 5; MISAIZU (US 6,594,214), figure 5; HASHIMOTO (US 6,370,096), figure 4 and MURATA (US 6,363,040), figure 4, etc.,), the session in KELLER et al form the same way, when track files (songs) has been selected and recorded on the

recordable disk and formed as a play-list and this play-list new session as applicant's claimed.

For that reasons, the claims are still rejectable as shown above.

7) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See form PTO-892 attached herein).

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (571)272-7586. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the

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receptionist whose telephone number is (703)305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

March 25, 2005